UNITED STATES PATENT AND TRADEMARK OFFICE

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10/586,128	07/17/2006	Dominique Quesselaire	09669/092001	1798

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EXAMINER
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ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
10/02/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 July 2006*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 July 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *17 July 2006*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   This action is in reply to the Preliminary Amendment filed on 17 July 2006.

2.   Claims 1-12 are currently pending and have been examined.

3.   All references to the capitalized versions of "Applicants" refer specifically to the

Applicants of record. Any references to lower case versions of "applicant" or

"applicants" refer to any or all patent "applicants." Unless expressly noted otherwise,

references to "Examiner" refers to the Examiner of record while reference to or use of

the lower case version of "examiner" or "examiners" refers to examiner(s) generally.

The notations in this paragraph apply to this Office Action and any future office action(s)

as well.

4.   This Office Action is given Paper No. 20080805. This Paper No. is for reference

purposes only.

Information Disclosure Statement

5.   The Information Disclosure Statement filed on 17 July 2006 has been

considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived
> by the manner in which the invention was made.

7.   Claims 1, 2, 4, 5, 7, 9, 10, and 12 are rejected under 35 U.S.C. §103(a) as being

unpatentable over Goldthwaite et al. (U.S. 2004/0019564 A1) ("Goldthwaite") in view of

Inotay et al. (W.O. 03/067530 A2) ("Inotay").

a.   **Regarding claims 1, 5 and 9**:

i.   Goldthwaite discloses the limitations:

(1)   *a human interface module* (mobile phone **110**) *comprising a*

keypad, a display, a card reader, a first processing means (CPU

202) *and an internal bus for connecting the keypad, the display, the*

card reader and the processing means (see figure 3, figure 5, and

associated text);

(2)   *a hosting means* (mobile phone **110**) *connectable to the*

human interface module through connection means, said hosting

means comprising a memory, a communication means, and a

power supply (see ¶ 0044); *and*

(3)   *a gateway means* (merchant server **104**) *connectable to the*

hosting means through a telecommunication network (Internet) (see

figure 2c and associated text).

ii.   Goldthwaite does not specifically disclose the following limitations;

Inotay, however, does disclose the limitations:

(4)   *said hosting means comprising a scheduler means*

("payment utility") *and a second processing means* ("a control unit")

(see at least the abstract and page 2, ¶ 3); *and*

(5)   *said gateway means being a virtual terminal server* (see at

least the abstract).

iii.   Therefore, it would have been obvious to one of ordinary skill in the

art, at the time the invention was made, to include in the mobile phone

with SIM of Goldthwaite the scheduler means and second processing

means as taught by Inotay since the claimed invention is merely a

combination of old elements, and in the combination each element merely

would have performed the same function as it did separately, and one of

ordinary skill in the art would have recognized that the results of the

combination were predictable.

iv.   Additionally, since each individual element and its function are

shown in the prior art, albeit shown in separate references, the difference

between the claimed subject matter and the prior art rests not on any

individual element or function but in the very combination itself – that is in

the substitution of the virtual terminal server of Inotay for the merchant

server of Goldthwaite. Thus, the simple substitution of one known

element for another, producing predictable results, renders the claim

obvious.

b.   **Regarding claims 2 and 10**:

v.   Goldthwaite/Inotay discloses the limitations of claims 1 and 9, as

described above. Goldthwaite/Inotay, further, discloses the limitations:

>   (6)   *wherein a transaction service provider* (financial institution
>
>   server **112**) *host is connectable to the gateway means* (see
>
>   Goldthwaite, figure 2c and associated text).

c.   **Regarding claims 4, 7, and 12**:

vi.   Goldthwaite/Inotay discloses the limitations of claims 1, 2, and 5, as

described above. Goldthwaite/Inotay, further, discloses the limitations:

>   (7)   *a gateway means* (merchant server **104**)
>
>   (8)   *a security module for performing secure communication with*
>
>   *the hosting means* (see figure 7 and associated text).

vii.   Although Goldthwaite does not specifically disclose *wherein the*

gateway means comprises a security module for performing secure

communication with the hosting means, it would have been obvious to one

of ordinary skill in the art, at the time the invention was made, to include in

the gateway means of Goldthwaite the security module as taught by

Goldthwaite since the claimed invention is merely a combination of old

elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

8.   Claims 3, 6, 8, and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Goldthwaite/Inotay, in further view of Buhler et al. (U.S. 2004/0012620 A1) ("Buhler").

    d.   **Regarding claims 3, 6, and 11**:

        viii.   Goldthwaite/Inotay discloses the limitations of claims 1, 2, and 9, as described above. Goldthwaite/Inotay does not specifically disclose the following limitations; Buhler, however, does disclose the limitations:

            (9)   *wherein the human interface module further comprises a printer* (see ¶ 0020).

        ix.   Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include with the human interface module of Goldthwaite/Inotay the printer as taught by Buhler since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

e.   **Regarding claim 8**:

x.   Goldthwaite/Inotay/Buhler discloses the limitations of claim 3, as

described above. Goldthwaite/Inotay/Buhler, further, discloses the

limitations:

(10)   *a gateway means* (merchant server **104**)

(11)   *a security module for performing secure communication with

the hosting means* (see figure 7 and associated text).

xi.   Although Goldthwaite does not specifically disclose *wherein the

gateway means comprises a security module for performing secure

communication with the hosting means*, it would have been obvious to one

of ordinary skill in the art, at the time the invention was made, to include in

the gateway means of Goldthwaite the security module as taught by

Goldthwaite since the claimed invention is merely a combination of old

elements, and in the combination each element merely would have

performed the same function as it did separately, and one of ordinary skill

in the art would have recognized that the results of the combination were

predictable.

9.   The Examiner has pointed out particular references contained in the prior art of

record within the body of this action for the convenience of the Applicant. Although the

specified citations are representative of the teachings in the art and are applied to the

specific limitations within the individual claim, other passages and figures may apply.

Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

10.   Although Applicants use "means for" in the claim(s) (*e.g.* see claim 1 which recites "a gateway means"), it is the Examiner's position that the "means for" phrases do not invoke 35 U.S.C 112 6th paragraph. If Applicants concur, the Examiner respectfully requests Applicants to either amend the claims to remove all instances of "means for" from the claims, or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked. Alternatively, if Applicants desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicants to expressly state their desire on the record. Upon receiving such express invocation of U.S.C. 112 6th paragraph, the "means for" phrases will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6¶*. Failure by Applicants in their next response to also address the 35 U.S.C. 112 6th paragraph issues in accordance with 37 C.F.R. §1.111 (b) or to be non-responsive to this issue entirely will be considered a desire by Applicants NOT to invoke 35 U.S.C. 112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6th paragraph applies to all examined claims currently pending.

11.   Using the broadest reasonable interpretation, the following definitions are relied upon by the Examiner when interpreting claim language:

　　　f.   ***virtual server*** "A virtual machine that resides on an HTTP server but has the appearance to the user of being a separate HTTP server. Several virtual

servers can reside on one HTTP server, each capable of running its own

programs and each with individualized access to input and peripheral devices.

Each virtual server has its own domain name and IP address and appears to the

user as an individual Web site. Some Internet service providers use virtual

servers for those clients who want to use their own domain names." (Computer

Dictionary, 5th Edition, Microsoft Press, Redmond, WA, 2002)

g.   *virtual machine* "Software that mimics the performance of a hardware

device, such as a program that allows applications written for an Intel processor

to be run on a Motorola chip." *Id*.

h.   *SIM card* "Short for Subscriber Identity Module card. A smart card

designed for use with GSM (Global System for Mobile Communications) mobile

phones. SIM cards contain chips that store a subscriber's personal identifier (SIM

PIN), billing information, and data (names, phone numbers). See also Global

System for Mobile Communications, smart card (definition 2)." *Id*.

i.   *smart card* "2. In banking and finance, a credit card that contains an

integrated circuit that gives it a limited amount of intelligence and memory." *Id*.

j.   *smart card reader* "A device that is installed in computers to enable the

use of smart cards for enhanced security features. See also smart card

(definition 2)." *Id*.

k.   *GSM* "Acronym for Global System for Mobile Communications. A digital

cellular phone technology first deployed in 1992. In 2000, GSM was the

predominant phone technology in Europe, and was used by 250 million

subscribers worldwide. GSM phones offer a removable smart card containing

subscriber account information. This card can be transferred from phone to

phone quickly and easily, allowing the user to access his account from any

phone in the system. Various enhancements to the GSM system allow increased

Web browsing and data transfer options." *Id*.

Conclusion

12.   In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-

35 (Fed. Cir. 2002), the Examiner finds that the reference <u>The Bank Credit Card</u>

<u>Business</u> by the American Bankers Association (hereinafter "ABA") is additional

evidence of what is basic knowledge or common sense to one of ordinary skill in this

art. The Examiner finds that ABA is a textbook that introduces the reader to the

dynamic bank credit card business. The reference is cited in its entirety. Moreover,

because of the reference's general description of the credit card business, because

"[w]ell known text books in English are obvious research materials," *In re Howarth*, 654,

F.2d 103, 210 USPQ 689, 692 (CCPA 1981), and after further review of the entire

record including the prior art now of record in conjunction with the factors as discussed

in MPEP §2141.03 (where practical), the Examiner finds that ABA is primarily directed

towards those of low skill in this art. Because ABA is directed towards those of low skill

in this art, the Examiner finds that one of ordinary skill in this art must-at the very least-

be aware of and understand the knowledge and information contained within ABA.

13.   In accordance with *In re Lee*, 277 F.3d at 1345, 61 USPQ2d at 435, the

Examiner finds that the references How Computers Work, Millennium Ed. By Ron

White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet

Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by

Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to

one of ordinary skill in this art. Each reference is cited in its entirety. Moreover,

because these references are directed towards beginners (see *e.g.* "User Level

Beginning…"), because of the references' basic content (which is self-evident upon

examination of the references), and after further review of the entire record including the

prior art now of record in conjunction with the factors as discussed in MPEP §2141.03

(where practical), the Examiner finds that these references are primarily directed

towards those of low skill in this art. Because these references are directed towards

those of low skill in this art, the Examiner finds that one of ordinary skill in this art

must—at the very least—be aware of and understand the knowledge and information

contained within theses references.

14.   Any inquiry of a general nature or relating to the status of this application or

concerning this communication or earlier communications from the Examiner should be

directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The

Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts

to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor,

Andrew Fischer can be reached at (571) 272-6779.

15.   Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, please contact the Electronic

Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C Coppola/
Examiner, Art Unit 3621
August 5, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621